REMARKS

Herein, the "Action" or "Office Action" refers to the Office Action dated 10/8/2003. The "Prior Action" refers to the Office Action dated 5/23/2003.

Applicant respectfully requests entry of the following remarks and reconsideration of the subject application. Applicant respectfully requests entry of the amendments herein. The remarks and amendments should be entered under 37 C.F.R. §1.116 as they place the application in better form for appeal, or for resolution on the merits.

Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-40 are presently pending. Claims amended herein are none. No claims are cancelled herein. No new claims are added herein.

The Applicant expressly grants permission to the Office to interpret all pending claims of this application.

Prior Art Status of References

Applicant does not explicitly or implicitly admit that any reference is prior art. Nothing in this communication should be considered an acknowledgement, acceptance, or admission that any reference is considered prior art.

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ANTICIPATION REJECTIONS

The §102 (Anticipation) Standard

In making out a §102 rejection, the Federal Circuit has stated that a reference anticipates a claim if it discloses every element of the claim. *See* Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991); Richard v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Thus, anticipation is determined by "identify[ing] the elements of the claims, determin[ing] their meaning in light of the specification and prosecution history, and identify[ing] corresponding elements disclosed in the allegedly anticipating reference." Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Consequently, if any claimed element is missing from the allegedly anticipating reference, then anticipation is negated. Kloster Speedsteel AB v. Crucible Inc., 793 F.3d 1565, 1571 (Fed. Cir. 1987). Close is not enough. Every element in the claim must exist in the allegedly anticipating reference for the §102 rejection to stand.

Claim Rejections under § 102

The Office rejects claims 1-2, 5-6, 8-9, 11-13, 15-16, 18-19, 21, 24-26, 28-35, and 37-39 under 35 U.S.C. § 102(e). Applicant traverses these rejections and asks that they be withdrawn and the case passed along to issuance.

The Office's rejections are based upon the following reference:

Hester: *Hester et al.*, U.S. Patent No. 6,105,101.

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Applicant expressly reserves the right to file a § 131 declaration with respect to Hester.

Hester

Hester is the reference for the anticipation rejections and the primary reference for the later-discussed obviousness rejection. So, Applicant will focus on a discussion on Hester here.

Hester's Purpose:

Hester describes its purpose as being a "mechanism of performing 16 Bit BIOS interrupt calls under a 32 Bit protected mode application" col. 2, lines 16-17.

BIOS:

Hester describes the BIOS as "The Basic Input/Output System (BIOS) is typically coded into a computer system's ROM to provide the basic *instructions* for controlling system hardware. The operating system and application programs both directly access the BIOS *routines* to provide better compatibility for such functions as screen displays" [emphasis added] col. 1, lines 44-49.

Applicant submits that the BIOS is not a "common configuration data structure" as recited in the claims. On its face, a "common configuration data structure" is a data structure that includes common configuration data. As indicated above, Hester describes the BIOS as being composed of "instructions" and "routines" for performing "functions." As such, it does not include a "data structure" and that structure does not include "common configuration data."

In this Action, the Office indicates that there is an irrelevant discussion of the "registry" in the response to the prior Action. However, what the Office is

referring to is a discussion about how the BIOS of Hester is not the same thing as the "common configuration data structure" of the claims. The "registry" is merely the example of a "common configuration data structure" used in the Application and used again in the response to the prior Action.

If the meaning of a "common configuration data structure" is not sufficiently clear, then Applicant directs attention to the discussion of the concepts of configuration, configuration databases, and common configuration data structures in the specification beginning on page 3.

Applicant does not submit that it has invented a "common configuration data structure" (of which the "registry" is one example). Rather, Applicant submits that the claim language recited operates on a "common configuration data structure" and that Hester does not.

Interrupt Call:

Hester says that "interrupt calls" are "used to *get the attention*' of some portion of a computer system" [emphasis added] col. 1, lines 53-54. Furthermore, Webopaedia™ (http://www.pcwebopaedia.com/) defines it as follows [emphasis added]: "A signal informing a program that an event has occurred. When a program receives an interrupt signal, it takes a specified *action*."

Applicant submits that a signal intended to "get attention" or initiate an "action" does not equate to an "attempt to access a storage locus" (like that described in claim 1). An interrupt call does not attempt to read or write to particular storage locus.

Claim 1

Claim 1 recites a method for controlling access to storage loci in a *common configuration data structure*, the method comprising:

- receiving an attempt to access a first storage locus in the *common configuration data structure* from a program module;
- determining whether to direct such attempt to at least a second locus in the *common configuration data structure* with the program module unaware that it is accessing the second locus.

The Office indicates that Hester discloses all of these features. Applicant submits that Hester does not.

In the context of this claim, here is how Applicant interprets Hester: a method for **redirecting interrupt calls to instructions sets in a BIOS**, the method comprising:

- receiving **an interrupt call that executes a first set of instructions in the BIOS** from a program module;
- determining whether to **execute a second set of instructions in the BIOS** with the program module unaware **of the execution of the second set of instructions.**

Applicant further submits that this may be further re-written using the above definitions of terms (provided by Hester and Webopedia) as follows: a method for **redirecting attention signals for taking action of executing instruction sets of a BIOS**, the method comprising:

- receiving **a first attention signal for a computer to take the action of executing a first set of instructions in the BIOS** from a program module;
- determining whether to **convert to a second attention signal for a computer to take the action of executing a second set of instructions in the BIOS** with the program module unaware **of the execution of the second set of instructions.**

If Applicant's above interpretation of Hester is incorrect, the Applicant asks the Office to expressly indicate where there is error in the interpretation.

Applicant asks for the Office to point out where Hester describes an interrupt call as "accessing a storage locus"; rather than a request to execute a set of instructions in the BIOS.

Applicant asks for the Office to point out where Hester describes an the BIOS as containing configuration data or anything other than instructions. If Hester does disclose this, then Applicant asks whether Hester redirects access to such non-instructions.

Applicant respectfully submits that the Office cannot maintain its rejection of claim 1 without clearly addressing these questions and by pointing out the specific portions of Hester that describe:

- an interrupt call as "accessing a storage locus"; rather than a request to execute a set of instructions in the BIOS.
- a redirection of access to non-instructions (and more particularly configuration data) in the BIOS.

Applicant submits that Hester does not appear disclose or suggest any such features. For at least this reason, Applicant respectfully submits that these claims are allowable. Accordingly, Applicant asks the Office to withdraw its rejections.

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Claims 9, 12, 29, 31, 33, and 39

While each of these independent claims are allowable for their own merits, each of these independent claims are allowable for the same reasons that claim 1 is allowable.

Like claim 1, Applicant respectfully submits that the Office cannot maintain its rejection of these claims without clearly addressing these questions by pointing out the specific portions of Hester that describe:

- an interrupt call as "accessing a storage locus"; rather than a request to execute a set of instructions in the BIOS.

- a redirection of access to non-instructions (and more particularly configuration data) in the BIOS.

Applicant submits that Hester does not appear disclose or suggest any such features. These features are found in each of these claims.

For at least this reason, Applicant respectfully submits that these claims are allowable. Accordingly, Applicant asks the Office to withdraw its rejections.

Furthermore, these claims are allowable because Hester does not disclose the following:

Claims 12 & 19: Hester does not disclose "intercepting an attempt by a program module to access **configuration information ("config-info") of the program module**" [emphasis added]. Applicant respectfully submits that the Office cannot maintain its rejection of these claims without pointing out the specific portions of Hester that disclose configuration information *of the program module* and such information being stored the BIOS.

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<u>Claim 29:</u> Hester does not disclose "a first storage locus containing **configuration information ("config-info") for a first version of a program module**; a second storage **locus containing config-info for a second version of the program module**" [emphasis added]. Applicant respectfully submits that the Office cannot maintain its rejection of this claim without pointing out the specific portions of Hester that disclose configuration information *of the first and second versions of program module* and such information being stored the BIOS.

Applicant submits that Hester does not appear disclose or suggest any such features. For at least this reason, Applicant respectfully submits that these claims are allowable. Accordingly, Applicant asks the Office to withdraw its rejections.

Claims 21, 29, 30, 32, and 37

The Office rejects these claims because their features are "inherent in claim 1 to enable backward compatibility...." Applicant disagrees.

Furthermore, Applicant respectfully submits that the Office has not met is burden and thus cannot maintain its rejection of these claims without "identify[ing] the elements of the claims, determin[ing] their meaning in light of the specification and prosecution history, and identify[ing] corresponding elements disclosed in the allegedly anticipating reference." <u>Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.</u>, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Accordingly, Applicant asks the Office to withdraw its rejections.

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Claims Dependent from Claims 1, 9, 12, 21, 29-33, 37, and 39

In addition to its own merits, each claim dependent from claims 1, 9, 12, 21, 29-33, 37, and 39 is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each dependent claim where its base claim is allowable.

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OBVIOUSNESS REJECTIONS

The § 103 Standard

To establish a prima facie case of obviousness, Applicant understands that there are at least three basic criteria that *must* be met and that the Office has the burden to show that these criteria are met. Those three criteria include:

- There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

- There must be a reasonable expectation of success of the combination. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

- The cited references must teach or suggest <u>all</u> of the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1439 (Fed. Cir. 1991).

Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of

whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.[1]

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.[2]

The need for specificity pervades this authority. [3]

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art *teaches away* from the claimed combination. A reference is said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the applicant took. *In re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir 1994).

In addition, the references must either be in the field of the inventor's endeavor, or reasonably pertinent to the specific problem with which the inventor

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[1] See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

[2] See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("'teachings of references can be combined only if there is some suggestion or incentive to do so.'") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)); In re Fritch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. [O]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.") (quoting In Re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

[3] See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

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was involved. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986). Put another way, the references must be in an art *analogous* to that of the invention.

The Office Has Not Made Out a Case of Prima Facie Obviousness

Applicant disagrees with the Office's obviousness rejections and respectfully submits that the Office has not made out a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests withdrawal of these rejections.

Claim Rejections under § 103

The Office rejects claims 3-4, 7, 10, 14, 17, 20, 22-23, 27, 36, and 40 under § 103. Applicant traverses these rejections and asks that they be withdrawn and the case passed along to issuance.

The Office's rejections are based upon the following references:

- **Hester**; and

- **Richman**, *Richman et al.*, U.S. Patent No. 5,655,148.

Applicant expressly reserves the right to file a § 131 declaration with respect to Richman.

Each of these claims (3-4, 7, 10, 14, 17, 20, 22-23, 27, 36, and 40) which are rejected based upon obviousness are depended from one of these independent claims: 1, 9, 12, 21, 29-33, 37, and 39. Those claims were rejected above based upon anticipation, but, as Applicant indicated above, each of these independent claims is allowable.

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In addition to its own merits, each claim dependent from claims 1, 9, 12, 21, 29-33, 37, and 39 is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each dependent claim where its base claim is allowable.

Dependent Claims

In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each dependent claim where its base claim is allowable.
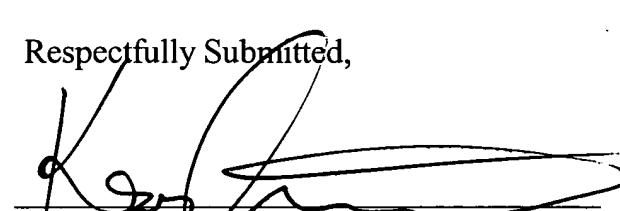
Conclusion

All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the Office is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully Submitted,

Dated: 12-8-03

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